

Appl. No. : **09/749,373**
Filed : **December 22, 2000**

COMMENTS

Claims 1-14 remain pending in the present application, Claims 1-4, 9, 13, and 14 having been amended. The claims set forth above include marking to show the changes made by way of the present amendment, deletions being in ~~strikeout~~ and additions being underlined.

Applicants would initially like to thank Examiner Hamilton for the courteous interview extended to Applicants' counsel, Michael Guiliana, on November 18, 2004. During the interview, Applicants' counsel and the Examiner discussed the rejections under 35 U.S.C. § 101 and §103. In particular, Applicants' counsel pointed out that all of the presently pending method claims recite steps that produce something concrete, tangible, and useful.

For example, during the interview, Applicants' counsel pointed out that one advantage of the inventions recited in the presently pending claims is that by including the step of or means for confirming that a payee of a check is a qualified charitable institution under the United States Internal Revenue Code, is that a party that purchases or receives such a check as a gift has complete freedom to use the check for any qualified charitable institution. In other words, the checks are not restricted to payment to a limited and predetermined number of charitable institutions. Rather, the checks can be used to make a donation to any party that is a qualified charitable institution under the United States Internal Revenue Code.

Presently, there are hundreds of thousands of such qualified charitable institutions (Page 1, lines 13-15 of the present specification). Additionally, the list of qualified charitable institutions changes often. Thus, by including the step of or means for verifying that the payee is a qualified charitable institution before transferring funds to the payee provides a significant improvement over the prior art charitable check methods and systems. For example, anyone who receives such a check has the option of entering, as the payee, any qualified charitable institution they wish. None of the prior art methods and systems teach this. Rather, all of the prior art systems and methods rely on a predetermined and static list of allowable payees.

One particular exemplary use of the present methods and systems is discussed at page 8, lines 1-6 of the present specification, as was also discussed during the interview. In this environment of use, an elementary school is presented with a number of checks to distribute

Appl. No. : 09/749,373
Filed : December 22, 2000

to students. The students can then research and give a donation, using the checks, to any qualified charitable institution.

Thus, the present checks allow the students maximum freedom to make a donation to any institution they wish. If the allowable charitable institutions were limited to a small subset of the institutions qualified under the U.S. IRS code, parents or the students' caregivers could be more likely to complain that the list is discriminatory. However, by allowing the checks to be used for any qualified institution, the students' teachers can give the students full freedom in deciding on a charity without the appearance of discrimination; an otherwise difficult task in today's politically-correct environment.

On the basis of the interview and in response to the Office Action mailed August 23, 2004, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

All Pending Claims Now Fully Comply With 35 U.S.C. § 112

Claims 1-3 and 9-14 stand rejected under 35 U.S.C. § 112, second paragraph, the Examiner maintaining that the language therein is indefinite as filed. In response, Applicants have amended Claims 1-3, 9, 13, and 14 solely to make these claims more easily readable and not to narrow or affect the scope of the claims. In particular, in response to each of the Examiner's rejections of the claims based on the lack of antecedent basis therein, Applicants have merely changed the word "the" to "a" or "an", among other similar changes.

Thus, Applicants submit that all of the equivalents of original Claims 1-14 are also equivalents of the presently pending versions of Claims 1-14. Additionally, all pending claims now fully comply with the requirements of 35 U.S.C. § 112.

All Pending Claims Fully Comply with 35 U.S.C. § 101

Claims 1-12 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse the present rejection.

It has long been established that "[F]or such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts." MPEP § 2106 (IV). Additionally, "[A] claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful." *Id.*

Appl. No. : 09/749,373
Filed : December 22, 2000

Claim 1 presently recites a number of steps that produce concrete, tangible, and useful results. For example, Claim 1 recites, among other recitations, “printing a philanthropy negotiable check...distributing said philanthropy check ...entering by said third party recipient the name of any qualified charitable institutions as payee ...delivering said philanthropy check...depositing said philanthropy check...confirming that said payee is a qualified charitable institution under United States Internal Revenue Code; and...transferring funds...” These steps are concrete actions, not mere manipulation of an abstract thought or concept. The other pending claims also recite similar concrete actions.

In support of the outstanding rejection, the Examiner cites the unpublished Board of Patent Appeals and Interferences decision in Ex parte Bowman for the proposition that a mere manipulation of an abstract idea or concept is not statutory subject matter under Section 101. In Bowman, Claim 1 recited:

1. A method of evaluating an intangible asset of interest, comprising the steps of:
 - establishing first and second variables related to the value of said intangible asset of interest;
 - establishing a series of performance criteria statements probative of the value of said first and second variables;
 - scoring each of said performance criteria statements;
 - summing scores to generate first and second total scores based upon the extent to which individual statements accurately describe said intangible asset of interest;
 - transforming physical media into a chart having a first axis relating to said first variable and a second axis relating to said second variable;
 - physically plotting a point on said chart, said point being located at coordinates corresponding to said first and second total scores, respectively, and,
 - using said chart in making at least one decision regarding the value of said intangible asset of interest.

Applicants recognize that, despite the recitation of “transforming”, Claim 1 of Bowman could be read to merely require the manipulation of an abstract idea. However, Claim 1 of Bowman is not analogous to Claim 1 or any of the claims pending in the present application. Rather, the presently pending claims recite positive steps that result in a concrete result. As one example, without reviewing every step or element recited in the presently pending claims, Claim 1 recites “transferring funds from said payor institution bank to said recipient qualified charitable institution after the payee has been confirmed to be a qualified charitable institution.” Applicants submit that no reasonable interpretation of this

Appl. No. : 09/749,373
Filed : December 22, 2000

portion of Claim 1 would result in a mere manipulation of an abstract idea. Rather, Claim 1 recites, among other recitations, that **funds are transferred between two parties.** (Emphasis added).

Claim 2 also stands rejected, the Examiner indicating that the system of Claim 2 must be a "system executed using a computer." Applicant submits that there is no basis in law for the requirement that any system, or part thereof, recited in a claim *must* be "implemented on a computer." Rather, Applicants submit that a "system claim" need not recite implementation on a computer. If this proposition were true, then no "system claim" could have been issued by the Patent Office prior to the invention of the computer. Applicants submit that Claim 2 properly recites a system having finite and statutory elements.

Applicants thus submit that all of the presently pending claims clearly recite statutory subject matter.

Prior Art Rejections

Claims 1-2 stand rejected under 35 U.S.C. § 103(a) as being obvious over Katz in view of Alcordo, and Claims 3-14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Katz. Applicants respectfully traverse the present rejection. However, in order to expedite prosecution of the present application, Applicants have amended Claims 1-3, 9, 13, and 14 to refer to the United States Internal Revenue Code, as discussed during the interview, to clarify the term regarding "qualified charitable institutions." Applicants also expressly reserve the right to further prosecute the original versions of Claims 1-14 through continuation practice.

As discussed during the interview, none of the prior art references, alone or in combination, teach or suggest a system or method in which the payee of the check is compared against the institutions qualified under the United States Internal Revenue Code before the funds are transferred to the payee. This provides a distinct advantage.

For example, as noted above, by including means for or steps in which the payee on the check is verified to be a qualified charitable institution under the United States Internal Revenue Code, the holders of the check are given full freedom to make a donation to any qualified institution. All of the cited prior art, including Katz and Alcordo, are limited to systems and methods in which the potential payees are, at best, limited to a predetermined group.

Appl. No. : 09/749,373
Filed : December 22, 2000

In contrast, the present systems and methods allow a holder of the present check to make a donation to any institution qualified by the IRS. As noted during the interview, the IRS continually changes the list of qualified charitable institutions. Thus, the check holder's options are dynamic, and in fact, can change from day to day. Further, in certain environments of use, such as where the check holders are students in a public school, the present checks provide a means for avoiding any appearance of discriminatory or non-politically-correct activities.

Applicant submit that Claims 1-14 clearly and non-obviously define over the prior art.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: November 23, 2004

By: 

Michael A. Guiliana
Registration No. 42,611
Attorney of Record
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404

H:\DOCS\MAG\CLIENTS\DORFF\DORFF001AM1.DOC
112304